



Our Reference: VWS-458-A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter J. Danish, et al.

Serial Number: 09/467,530

Filing Date: December 20, 1999

Examiner/Art Group Unit: Perez, G./2834

Title: WINDSHIELD WIPER MOTOR WITH
MOLDED SLEEVE AND THRUST
ELEMENTS

PETITION TO RECONSIDER REFUSAL TO ENTER
AFTER FINAL AMENDMENT TO THE SPECIFICATION

Mail Stop: Appeal Brief-Patents
Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

In the Office Action dated July 24, 2003, the Examiner rejected claims 29-44 by objecting to the specification as failing to provide proper antecedent basis for the claimed subject matter. The Examiner indicated that correction of the following was required: the specification does not disclose means for preventing rotation of the plastic annular sleeve with respect to the housing, as recited in new claims 29, 33, 37, and 41; and does not disclose means for preventing rotation of the plastic thrust member with respect to the housing, as recited in new claims 31, 35, 39, and 43. The Examiner rejected claims 29-44 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for the same reasons. It is submitted that an After Final Amendment including an amendment to the specification to incorporate a written description of the function inherently disclosed in the drawings as originally filed (see Figures 1-5) was filed on October 24, 2003, and was refused entry by the Examiner in the Advisory Action dated December 16, 2003.

In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicated by resort to known scientific laws. *See In re Fisher*, 427 F.2d 833, 166 USPQ 18 (C.C.P.A. 1970). The C.C.P.A. has described the general test for determining whether a drawing can constitute an adequate written description of the invention under §112, first paragraph as follows:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason *that* what *is* originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it *can* "form the basis of a valid claim."

See in re Wolfensperger, 302 F.2d 950, 133 USPQ 537 (C.C.P.A 1962) (emphases in original). The C.C.P.A. has also stated the following general rule for determining when subject matter is inherently disclosed in the specification:

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

See in re Smythe, 480 F.2d 1376, 178 USPQ 279, 285 (C.C.P.A. 1973). In the present application, original drawing Figures 1-5 illustrate first gate 46 and second gate or runner 48 extending at an angle generally transverse to the sleeve 32 and corresponding thrust bearing 34. When molded, the structure inherently defines means for preventing rotation of the sleeve 32 with respect to the housing 12, and means for preventing rotation of the thrust bearing 34 with respect to the housing. Therefore, the specification of the present application should be amendable to include a written description of the invention consistent with that disclosed in the original drawing figures as submitted in the After Final Amendment refused entry by the Examiner.

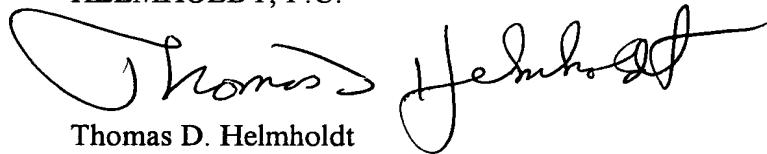
Application Serial No. 09/467,530
Date December 23, 2003
Reply to Office Action dated July 24, 2003

Page 3 of 3

Accordingly, reversal of the Examiner's refusal to enter the After Final
Amendment is requested.

Respectfully submitted,

YOUNG, BASILE, HANLON, MacFARLANE, WOOD &
HELMHOLDT, P.C.



Thomas D. Helmholdt
Attorney for Applicant(s)
Registration No. 33181
(248) 649-3333

3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107

Dated: December 23, 2003
TDH/cmp